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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,793	10/27/2003	Eugene M. Lee	113708.129 US1	1059
23400	7590	12/13/2006		
POSZ LAW GROUP, PLC 12040 SOUTH LAKES DRIVE SUITE 101 RESTON, VA 20191			EXAMINER TRAN, QUOC A	
			ART UNIT 2176	PAPER NUMBER

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/692,793	<b>Applicant(s)</b> LEE ET AL.	
	<b>Examiner</b> Tran A. Quoc	<b>Art Unit</b> 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-10, 13-18 and 20-54 is/are pending in the application.
- 4a) Of the above claim(s) 29-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-10, 13-18, 20-28 and 54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/16/06, 5/26/04, 01/30/2006</u> | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. This action is a final rejection in response amendment filed on 09/22/2006.
2. Claims 1-4, 6-10, 13-18, 20-28 and 54 are pending. Claims 5, 11-12, and 19 have been canceled. Claims 29-53 have been withdrawn
3. Claims 1-4, 6-7, 9-10, 13, 16-18, 20-21, and 24-26 are amended. Claim 54 is new
4. Effective filing date 10/27/03, benefit from 60/315,021 filed on 08/28/2001.

### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

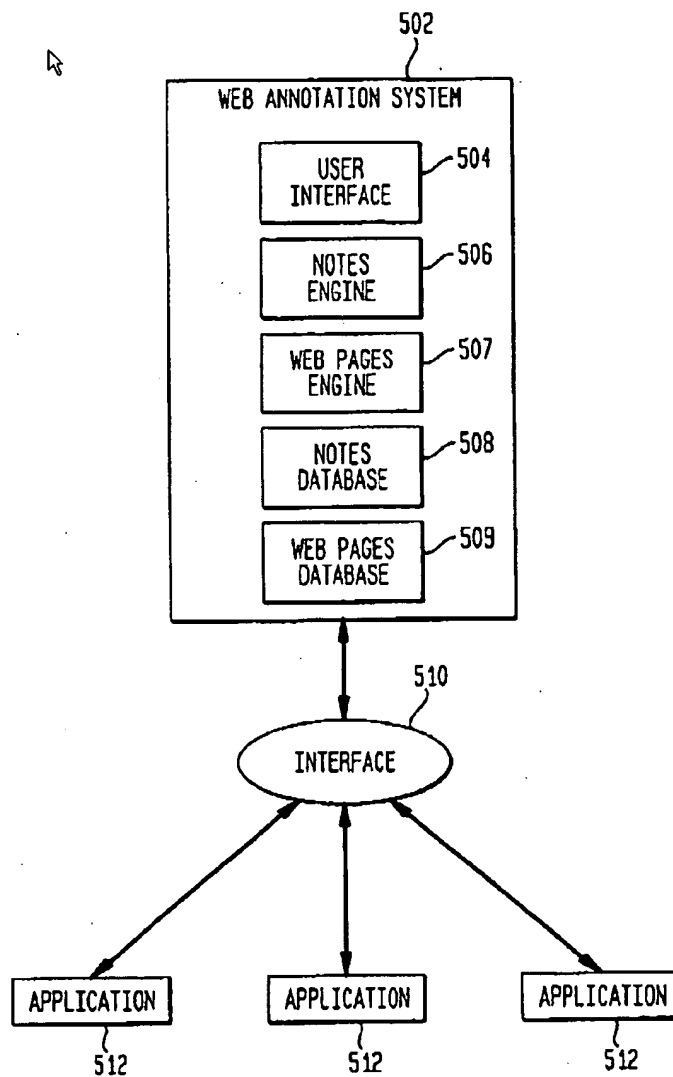
*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

6. **Claims 1-4, 6-10, 13-18, 20-28 and 54** are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette'137 et al. US006877137B1- filed 12/07/1999 (hereinafter Rivette'137), in view of Rivette'137 et al. US006389434B1- filed 08/09/1998 (hereinafter Rivette'434).

**Regarding independent claim 1, Rivette'137 teaches (A) an annotation component configured to determine, responsive to at least one user, at least one annotation to be applied to at least one document, including a selection resource to select at least a portion of the at least one document and to associate the at least one annotation therewith. Specifically Rivette'137 discloses web annotation system (item 502 Fig. 5) the plurality components (items 504-509, fig. 5) for Web annotation**

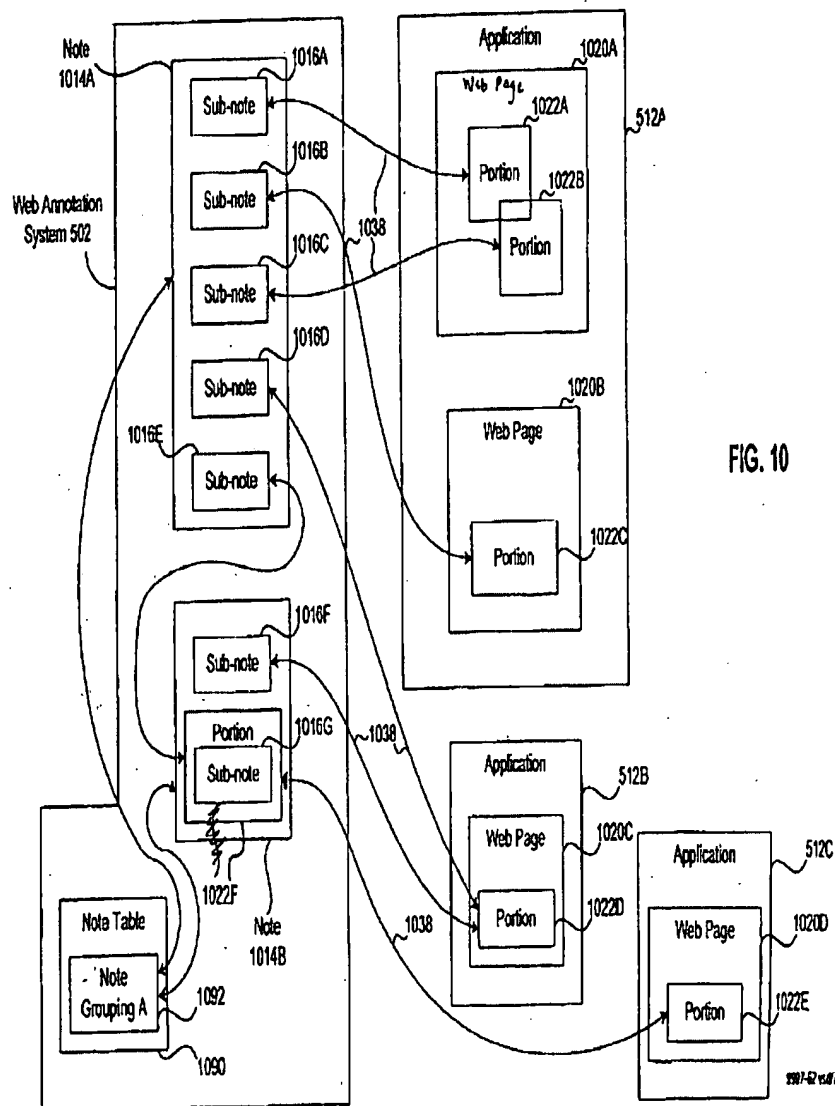
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(Rivette'137, col. 13, lines 5-10). In addition Rivette'137 discloses user interface (item 504, fig. 5) creates, updates, and deletes objects in the Web annotation system 502 preferably using the COM interfaces (Rivette'137, col. 17, lines 10-20).

**FIG. 5**

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Furthermore Rivette'137 discloses web annotation system using Component Object Model, Jscript or DHTML component for controlling annotation system. Whereby enable a user to create an annotation to a web page, and links the annotation to the selected portion (Rivette'137 at col. 4, line 60 through col. 5 and Fig. 10 items 502, 1014A, 1016A and 1020A-1022B).



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Furthermore Rivette'137 teaches **(B) a reference component, responsive to the at least one user, configured to at least one of establish, traverse, indicate, and remove, at least one reference between the at least one portion and at least one of an other portion of the at least one document, an other document, and at least one other portion of the other document.** Specifically Rivette'137 discloses a user interface for accessing and traverse the function provides by the web annotation system item 502 (Rivette'137, col. 31, lines 5-25). Also Rivette'137 discloses portions of Web pages can be stored at a Web site or in a local file system. The method of linking notes to web pages operates by enabling a user to select a portion of a Web page, creating a annotation, linking the annotation to the selected portion, receiving a request from a user viewing the annotation to display the selected portion linked to the annotation, and invoking an application, and for causing the application to load the Web page and present the selected portion (Rivette'137 at the Abstract).

In addition Rivette'137 teaches **a mark-up resource to at least one of add and edit the at least one annotation.** For example Rivette'137 discloses creating a annotation, linking the annotation to the selected portion, receiving a request from a user viewing the annotation to display the selected portion linked to the annotation, and invoking an application, and for causing the application to load the Web page and present the selected portion (Rivette'137 at the Abstract).

Rivette'137 teaches **to retrieve at least one document from the first data storage as document data.** For example Rivette'137 discloses portions of Web pages can be stored at a Web site or in a local file system (Rivette'137 at the Abstract). In addition Rivette'137 teaches **to retrieve the at least one annotation be applied to said**

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**at least one document from a second storage as annotation data.** For example Rivette'137 discloses receiving a request from a user viewing the annotation to display the selected portion linked to the annotation, and invoking an application, and for causing the application to load the Web page and present the selected portion (Rivette'137 at the Abstract).

Rivette'137 does not explicitly teach **(C) at least one merge component configured to combine the annotation data and the document data to form a single logical document, the single logical having the annotation data embedded in the document data**, but Rivette'434 teaches this limitation. Specifically Rivette'434 describes Microsoft Word and Microsoft Excel allows users to attach notes to their document where he wishes to insert the note utilizing Object Linking Embedded (OLE) (Rivette'434 col. 2, lines 50-65 and col. 9, line 20-25). In addition Rivette'434, fig. 3B, 4, and 6A-B, item 302, 402, 602, 604, 606, and 608 illustrate the example screen display of Rivette'434 configuring to combine the annotation data and the document data to form a single logical document, the single logical having the annotation data embedded in the document data (Rivette'434, col. 14 line 50 – col. 15, line 15, fig 3B, 4, and 6A-B).

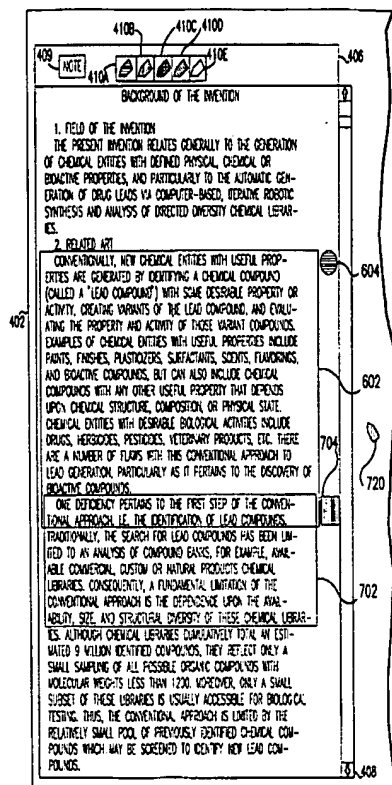


FIG. 7A

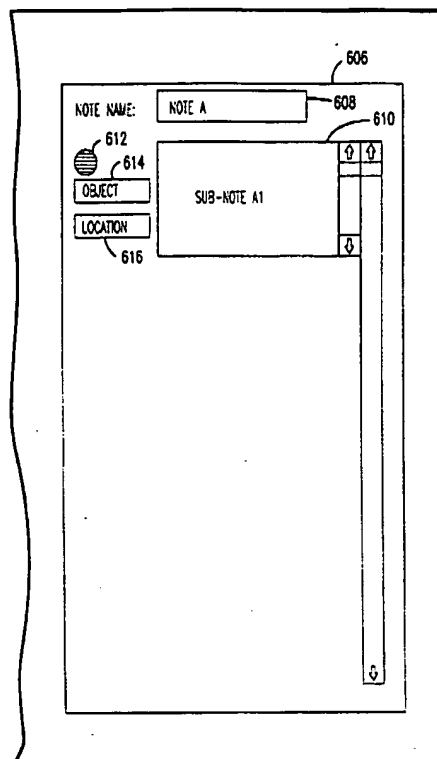


FIG. 6B

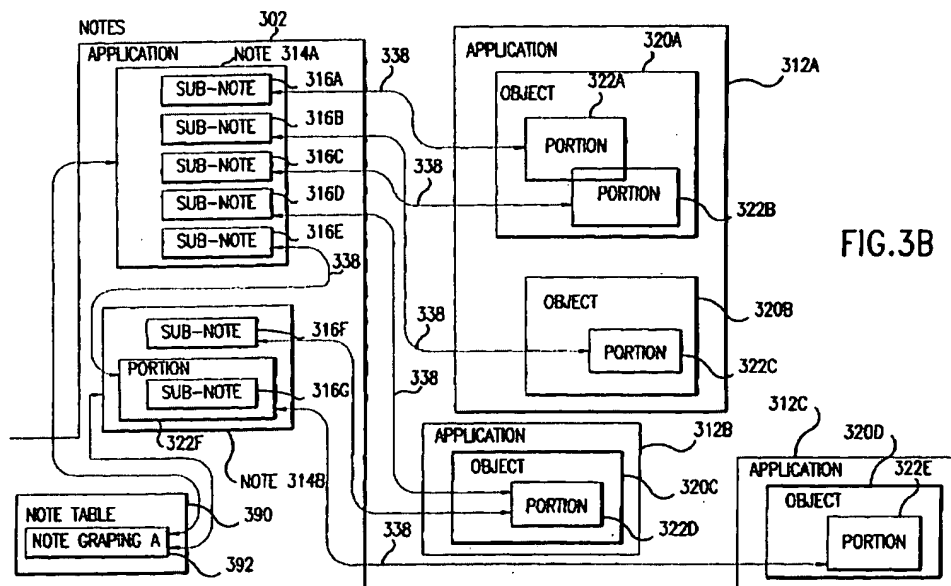


FIG. 3B



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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified the teaching of Rivette'137, to include at least one merge component configured to combine the annotation data and the document data to form a single logical document, the single logical having the annotation data embedded in the document data of Rivette'434 teaching. One of the ordinary skill in the art would have been motivated to perform such a modification, because Rivette'137 and Rivette'434 are from the same field of endeavor of utilizing Object Linking Embedded (OLE) to create an annotation to a web page, and enabling user to attaching, grouping, embedded note to some computer applications as Microsoft Word, Word Perfect, and Excel (Rivette'137 col. 3, lines 35-60).

**Regarding independent claim 18**, the rejection of claim 1 is fully incorporated. In addition Rivette'137 teaches **document data including at least one element corresponding to a location of the at least one annotation within said document**. For example Rivette discloses the bi-directional hyperlink that a user associates with the part of the Web page he/she has selected (Rivette'137 at col. 10, lines 30-35). Also Rivett'137 discloses Hypertext Markup Language (HTML) (see Rivette'137 at col. 2, lines 20-35).

The examiner equates Rivett'137 teaching of Hypertext Markup Language (HTML) to the claimed invention, because it is the authoring language used to create documents or pages accessible on the Web, whereby Hyperlinks are a common function of the Internet (a hyperlink is an element in an electronic document that links to another place in the same document or to an entirely different document in the Web environment).

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Furthermore Rivette'137 teaches **(C) at least one version component, configured to at least one of manage a history of changes and to maintain a separate version for the document data and the annotation data to be applied thereto.**

Specifically Rivette'137 discloses notes can be grouped together under one note grouping, note table (item 1090) or other database construct is used to keep track of which notes are in which note groupings (Rivette'137 at col. 18, lines 55-60 fig. 10 item 502 and 1090).

In addition Rivette'137 teaches **at least one split component, configured to update the at least one annotation in the first data storage from the extracted annotation data, and to update the at least one document in the second data storage from the extracted document data.** Specifically Rivette'137 discloses loses portions of Web pages can be stored at a Web site or in a local file system (Rivette'137 at the Abstract). In addition Rivette'137 teaches receiving a request from a user viewing the annotation to display the selected portion linked to the annotation, and invoking an application, and for causing the application to load the Web page and present the selected portion (Rivette'137 at the Abstract).

**Regarding independent claim 25,** the rejection of claims 1 and 18 are fully incorporated. In addition Rivette'137 teaches **in the computer system and in responsive to user.** Specifically Rivette'137 discloses a web annotation system (item 502 Fig. 5) the plurality components (items 504-509, fig. 5) for Web annotation (Rivette'137, col. 13, lines 5-10). In addition Rivette'137 discloses user interface (item 504, fig. 5) creates, updates, and deletes objects in the Web annotation system 502 preferably using the COM interfaces (Rivette'137, col. 17, lines 10-20).

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The Examiner equates the claimed **in responsive to user in the computer system** to Rivette'137 suggests of the user interface of fig. 10 of Rivette'137.

**Regarding dependent claim 2**, the rejection of claims 1 and 18 are fully incorporated. In addition Rivette'137 teaches **a view component to select the at least one portion, and to edit, responsive to the at least one user, the at least one portion.** Specifically Rivette'137 discloses a web annotation system (item 502 Fig. 5) the plurality components (items 504-509, fig. 5) for Web annotation (Rivette'137, col. 13, lines 5-10). In addition Rivette'137 discloses user interface (item 504, fig. 5) creates, updates, and deletes objects in the Web annotation system 502 preferably using the COM interfaces (Rivette'137, col. 17, lines 10-20).

**Regarding dependent claims 3-4, 7-10, 13, 15-16, 23-24**, the rejection of claims 1, 18, and 25 are fully incorporated.

**Regarding dependent claims 6, and 20**, the rejection of claims 1, 18, and 25 are fully incorporated. In addition Rivette'137 teaches **the document data and the annotation data is at least one of: XML format, binary format, image data, video data and audio data.** For example Rivette'137 discloses each sub-note includes a content data that which can be any format or combination of formats, such as text, sound, video, image, executable program, tactile, etc (Rivette'137, col. 18, lines 10-30).

**Regarding dependent claims 14, 22 and 27**, the rejection of claims 1, 18, and 25 are fully incorporated. In addition Rivette'137 teaches **at least one annotation includes at least one of: a pre-defined notation, a user-provided text, a user-defined attribute, a reference to a URL, and a reference to one other file.** For example Rivette'137 discloses a web annotation system (item 502 Fig. 5) the plurality

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components (items 504-509, fig. 5), includes a web page's image and its text, that are associated with notes stores in notes database (item 508), via the Internet (Rivette'137, col. 11, lines 40-65, fig. 5).

**Regarding dependent claims 17 and 28, Rivette'137 teaches the system of claim 1, wherein at least one document is an intelligent property document.** For example Rivette'137 discloses Rivette' invention is applicable to law related project (patentability)(Rivette'137, col.39, lines 10-25).

**Regarding dependent claim 21, the rejection of claims 1, 18, and 25 are fully incorporated. In addition rivette'137 teaches, a schema to identify at least one tag in the at least one element, and logic to determine tags for at least one of the document data, the annotation data, and the at least one marked-up representation.** For example Rivette'137 discloses that one or more of notes are grouping in a table, whereby all the notes and sub notes from the table can be links to the appropriate portion of the target web page as selected by user using the OLE standard is based on the Component Object Model (COM), Jscript or DHTML for controlling the web annotating system Fig. 10 item 502 (Rivette'137 at col. 20, lines 15-20).

It is noted that, the OLE standard is based on the Component Object Model (COM), Jscript or Dynamic Hypertext Markup Language (DHTML) is the authoring language used to create documents or pages accessible on the Web, whereby Hyperlinks are a common function of the Internet; A hyperlink is an element in an electronic document that links to another place in the same document or to an entirely different document in the Web environment, (see Rivette'137 at col. 2, lines 20-35), can be

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reasonably interprets as claimed a schema to identify at least one tag in the at least one element, and logic to determine tags. Since Dynamic Hypertext Markup Language (DHTML) is well known as logically linking element in an electronic document that links to another place in the same document or to an entirely different document in the Web environment using tag schema in collaborating with Component Object Model (COM), Jscript using in Rivette'137 web annotating system.

**Regarding dependent claim 26**, the rejection of claims 1, 18, and 25 are fully incorporated. In addition Rivette'137 does not explicitly teach **in visual correspondence thereto a summary of each portion in the at least one document that is in associated with each annotation**, but Rivette'434 teaches this limitation. Specifically Rivette'434 describes Microsoft Word and Microsoft Excel allows users to attach notes to their document where he wishes to insert the note utilizing Object Linking Embedded (OLE) (Rivette'434 col. 2, lines 50-65 and col. 9, line 20-25). In addition Rivette'434, fig. 3B, 4, and 6A-B, item 302, 402, 602, 604, 606, and 608 illustrate the example screen display of Rivette'434 configuring to combine the annotation data and the document data to form a single logical document, the single logical having the annotation data embedded in the document data (Rivette'434, col. 14 line 50 – col. 15, line 15, fig 3B, 4, and 6A-B).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified the teaching of Rivette'137, to include at least one merge component configured to combine the annotation data and the document data to form a single logical document, the single logical having the annotation data embedded in the document data of Rivette'434 teaching. One of the ordinary skill in the art would have been motivated to perform such a modification, because Rivette'137 and

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Rivette'434 are from the same field of endeavor of utilizing Object Linking Embedded (OLE) to create an annotation to a web page, and enabling user to attaching, grouping, embedded note to some computer applications as Microsoft Word, Word Perfect, and Excel (Rivette'137 col. 3, lines 35-60).

**Regarding dependent claim 54**, the rejection of claims 1, 18, and 25 are fully incorporated.

### *Response to Argument*

7. Applicant's arguments filed 09/22/06 have fully considered but they are not persuasive.

Regarding claims 1-4, 6-10, 13-18, 20-54, Applicant argues that the references do not teach teaches the newly amended limitations. The Examiner disagrees, to address these amendments; the Examiner introduces the Rivette'434 reference (see rejection above for details).

In addition, Applicant argues the references do not teach **combines (merge) merge component that combines the annotation data and the web page into a single document** (see Remark pages 21-25). The Examiner disagrees. For example, Rivette'137 discloses user interface of a web annotation system (item 502 Fig. 5) the plurality components (items 504-509, fig. 5) for Web annotation (Rivette'137, col. 13, lines 5-10) to retrieve at least one document from the first data storage as document data and to retrieve the at least one annotation be applied to said at least one document from a second storage as annotation data (the rejection of claims 1, 18 and 25 are fully incorporated, see above rejection for details).

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To clarity and further consideration, the Examine introduces Rivette'434. Specifically Rivette's434 describes the well known Object Linking Embedded (OLE) of Microsoft Word and Microsoft Excel, allows users to attach notes to their document where he wishes to insert the note utilizing Object Linking Embedded (OLE) (Rivette'434 col. 2, lines 50-65 and col. 9, line 20-25). In addition Rivette'434 illustrate the example screen display as resulting of Rivette'434 configuring to combine the annotation data and the document data to form a single logical document, the single logical having the annotation data embedded in the document data. For example Patent (item 602) is a visual presentation of embedded note link button (item 604) in combination with a portion of patent (item 702) in one logical document (item 402) (Rivette'434, col. 14 line 50 – col. 15, line 15, fig 3B, 4, 6A-B, and 7A).





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Furthermore, Applicant argues the references do not teach **updated from the extract document data** (see Remark page 21). The Examiner disagrees, Specifically Rivette'137 discloses web annotation system (item 502 Fig. 5) the plurality components (items 504-509, fig. 5) for Web annotation (Rivette'137, col. 13, lines 5-10). In addition Rivette'137 discloses user interface (item 504, fig. 5) creates, updates, and deletes objects in the Web annotation system 502 preferably using the COM interfaces (Rivette'137, col. 17, lines 10-20).

In addition, Applicant argues **the references do not establish a prima facie case of obviousness to combine**. The Examiner disagrees, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified the teaching of Rivette'137, to include at least one merge component configured to combine the annotation data and the document data to form a single logical document, the single logical having the annotation data embedded in the document data of Rivette'434 teaching. One of the ordinary skill in the art would have been motivated to perform such a modification, because Rivette'137 and Rivette'434 are from the same field of endeavor of utilizing Object Linking Embedded (OLE) to create an annotation to a web page, and enabling user to attaching, grouping, embedded note to some computer applications as Microsoft Word, Word Perfect, and Excel (Rivette'137 col. 3, lines 35-60).

Therefore the Examiner respectfully maintains the rejection of 1-4, 6-10, 13-18, 20-54 at this time.

*Conclusion*

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quoc A. Tran whose telephone number is 571-272-8664. The examiner can normally be reached on Monday through Friday from 9 AM to 5 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Herndon R. Heather can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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*Quoc A. Tran*  
*Patent Examiner*  
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*December 11, 2006*